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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,887	07/25/2003	Ronald Hoagland	HOAG/0702	3826

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BENJAMIN APPELBAUM, PH.D.
ATTORNEY AT LAW
27 BENNINGTON DRIVE
FLANDERS, NJ 07836

EXAMINER

ROBERTS, LEZAH

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/627,887	Applicant(s) HOAGLAND, RONALD	
	Examiner Lezah W. Roberts	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a method for preparing to go hunting, classified in class 422, subclass 5 plus.
- II. Claims 8, 9, 13, and 14, drawn to a method to attract animals toward a hunter, classified in class 433, subclass 216 plus.
- III. Claims 10-12, drawn to a toothpaste, classified in class 424, subclass 52 plus.

Inventions I and II are independent and unrelated. Inventions are independent and unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I is a method of preparing to go hunting by brushing one's teeth with scentless toothpaste in order not to be detected. Invention II is a method to go hunting by brushing one's teeth with scented toothpaste in order to attract animals. These are clearly unrelated since they are opposite in design and effect.

Inventions I and III are related as process and product of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

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different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case of invention III, the toothpaste can be used for everyday use for oral hygiene.

Inventions II and III are related as process and product of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case of invention III, the toothpaste can be used for everyday use for oral hygiene.

Because these inventions are distinct or independent for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search required for Group I is not required for Group II or III and the search for II is not required for Group II or III, restriction for examination purposes as indicated is proper.

During a telephone conversation with Benjamin Appelbaum on August 11, 2005 a provisional election was made with traverse to prosecute the invention of group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims

Objections

Claims 3-5 and 7 are objected to because of the following informalities:

"unnatural" is used in the claim whereas "non-natural" is used in the specification.

Unnatural was not defined in the specification. Appropriate correction to the claim is required.

Claim 7 is objected to because it is dependent on dependent claim 4 yet follows independent claim 6. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Rejections, Indefiniteness

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 4 and 5 recite the limitation the dentifrice in claim 3 is a toothpaste and toothpowder respectively. Claim 3 does not make reference to a dentifrice. There is insufficient antecedent basis for this limitation in the claim.

Rejections, Anticipation

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1) Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Johnson (US 6,340,447).

Johnson teaches a regimen for hunting including using activated carbon containing personal items to reduce the hunter's scent. The personal items include mouthwash, deodorant/anti-perspirant, body and boot powder, bar and liquid soap for cleansing the body and hair, laundry detergent and dryer sheets (see abstract). The use of activated carbon reduces the scent of the hunter by absorbing the scent. It can be reasonably inferred the activated carbon containing products would have no added scent since the objective of the reference is to eliminate odor before going hunting.

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2) Claims 1-4 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Kreh.

Kreh discloses procedures and products used in preparation to go hunting. According to the reference, brushing the teeth and tongue with toothpaste should be done with the addition of rinsing the mouth with "Vanishing Hunter" and spitting it out. This eliminates the odor from the mouth than can alert what is being hunted to the hunter's presence (column 2, page 6). The disclosure by Kreh clearly anticipates claim 1, which recites applying a dentifrice to the teeth having no added scent in preparation to go hunting. The reference also anticipates the use of toothpaste with no added scent as indicated in claims 2-4 and 6. It would be inherent for the toothpaste to have no added scent given that the clear intent of the prior art is one of eliminating odor in preparation to go hunting.

3) Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Delaney et al. (US 3,935,305).

The instant preamble "a method to prepare for hunting" is viewed as non-limiting since it does not recite essential steps "necessary to give life, meaning and vitality" to the claimed subject matter. Pitney Bowes, 51 USPQ2d at 1165-66; Kropa V. Robie, 88 USPQ 478, 480-81 (CCPA 1951). The body of the claim following the preamble is a self-contained description of the method (brushing one's teeth with an effective amount of tooth paste to reduce the odor of the hunter, the toothpaste formulated to have no added scent) and does not depend on the preamble for completeness. (One could

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brush their teeth with the toothpaste composition disclosed by patentee in preparation to go hunting and not go hunting). The body of the claim lacks a statement or step specifying what occurs after brushing one's teeth with toothpaste, such as "and then going hunting".

Rejections, Obviousness

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1) Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Rajaiah et al. (US 6,509,007).

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The primary reference is described above. The reference differs from the claims insofar as it does not disclose toothpaste to be used in preparation for hunting that contains no scent or absorbs odors within the mouth.

Rajaiah et al. discloses oral compositions consisting of toothpaste, tooth gels, pastes, irrigants, ointments, films, dental gels, mouth rinse, mouth spray, chewing gum, lozenges and a base composition for coating toothpicks and dental floss (see abstract). When formulating and marketing oral compositions, more than one type of dentifrice is generally prepared to satisfy the particular needs and preferences of different consumers. Such materials are selected from those well known in the art and are readily chosen based on the physical and aesthetic properties desired for the composition being prepared (column 11, lines 30-34). This coincides with the option of toothpaste or toothpowder compositions used for the preparation to go hunting recited in claims 2-7. The reference differs from the claims insofar as it does not disclose that the purpose of the oral formulations is for the preparation to go hunting.

It would have been obvious to have prepared the mouthwash compositions of the primary reference in alternative and equivalent dentifrice forms, e.g. as toothpastes, motivated by the desire to provide products to appeal to the widest possible consumer base as illustrated by Rajaiah et al.

2) Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kreh in view of Delaney et al. (US 3,935,305).

The primary reference is described above. The reference differs from the claims insofar as to not specifically describe toothpastes that have specific compositions should be used before going hunting.

Delaney et al. discloses toothpaste compositions having excellent overall cleaning and polishing power containing 20 to 60 % calcium carbonate (of toothpaste composition, column 3, lines 7-12), 1 to 25 % sodium bicarbonate (column 3, lines 31-33), above 0.1% of titanium dioxide (column 5, lines 12-16), 5 to 35% water (column 5, lines 25-27), 0.5 to 2% thickening agent (column 5, line 58-60), 0.8 to 1.2 % saccharine (column 7, lines 21-27), and 0.05 to 5 % surface-active agent (column 6, lines 58-61). These teachings encompass what is recited by claim 7. The reference differs from the claim insofar as it does not disclose that the purpose of the toothpaste compositions are for the preparation to go hunting.

One of ordinary skill in the art would have used the toothpaste composition of Delaney et al. in the procedure of Kreh, motivated to formulate a toothpaste that does not require added flavor that would cause a scent or added scent and which would also have excellent over-all cleaning and polishing power (column 1, lines 48-50 and column 7, line 14).

3) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kreh in view of Winston et al. (US 4,547,362).

The primary reference is described above. The reference differs from the instant claim insofar as it does not disclose the use of toothpowder in preparation to go hunting.

Winston et al. discloses a toothpowder containing sodium bicarbonate as well as calcium carbonate. The secondary reference discloses other ingredients as well but does not disclose adding a scent to the powder. The reference teaches that powders are preferred to toothpastes because they are lighter and easier to carry, as well as more economical (column 1, lines 41-49). The secondary reference differs from the claim by not disclosing the use of the toothpowder, before hunting, to reduce the odor of a hunter that would be considered "unnatural" by the hunter's prey.

It would be obvious to one of ordinary skill in the art to have incorporated toothpowder into the preparation to go hunting method of Kreh, motivated by the desire to provide a product lighter and easier to carry as well as more economical as taught by Winston et al.

Claims 1-7 are rejected.

No Claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

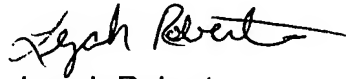
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick Krass
Primary Examiner
Art Unit 1614



Lezah Roberts
Patent Examiner
Art Unit 1614